

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

N. Sundaresan

Serial No.: 09/672,304 **Group Art Unit:** 2161

Filed: September 29, 2000 **Examiner:** Alaubaidi, Haythim J.

For: METHOD AND SYSTEM FOR SELECTIVELY ACCESSING FILES
ACCESSIBLE THROUGH A NETWORK

Honorable Commissioner of Patents
Alexandria, VA 22313 - 1450

REQUEST TO REINSTATE APPEAL UNDER 37 C.F.R. §1.193(b)(2)(ii)

Sir:

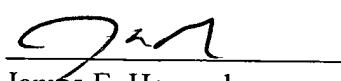
Appellant respectfully requests reinstatement of the appeal that was filed on April 7, 2005. Appellant filed an Appeal Brief on June 7, 2005 and the Examiner issued a Final Office Action on August 19, 2005, which raised a new issue.

Appellant encloses a Supplemental Appeal Brief, which addresses the new issue raised by the August 19, 2005, Final Office Action, and respectfully requests reinstatement of the Appeal under 37 C.F.R. §1.193(b)(2)(ii).

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

Date: 10/19/05


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SUPPLEMENTAL APPEAL BRIEF

Sir:

This paper is a Supplement to the Appeal Brief that was filed on June 7, 2005, which is on appeal from the Examiner's Final Rejection of all claims 1-23 in an Office Action dated December 8, 2004. This Supplemental Appeal Brief addresses the issues which were newly raised, yet finally rejected, by the August 19, 2005, Office Action, with which the Examiner attempted to re-open prosecution.

I. REAL PARTY IN INTEREST

The real party in interest in the present application is International Business Machines Corporation pursuant to an Assignment of 100% interest in the patent application under appeal that was recorded on September 29, 2000, by the United States Patent and Trademark Office at Reel No. 011161, Frame No. 0628.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative, or Assignee, which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-23 are all the claims presently pending in the application. Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as being anticipated by the Ronning et al. reference in view of the Yamane et al. reference.

In the August 19, 2005, Office Action the Examiner newly rejects claims 1-23 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement based upon an amendment which was filed on June 7, 2004. Therefore, claims 1-23 now also stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 1, 7, 17, and 23 are independent.

All of the currently pending claims 1-23 are appealed.

IV. STATUS OF AMENDMENTS

The Amendment filed on February 8, 2005, in response to the December 8, 2004, Office Action, was not entered by the Examiner as allegedly raising new issues.

The most recently entered Amendment was filed on June 7, 2004.

The claims in the attached Appendix reflect the version of the claims after entry of the June 7, 2004, Amendment.

V. SUMMARY OF CLAIMED SUBJECT MATTER

An exemplary embodiment of the claimed invention is directed to a method for searching files stored on a network. The method includes downloading a first file on the network from a server to a client (steps 110 and 120 of Figure 1, page 7, lines 13 - 16), accessing time data from within the first file (also steps 110 and 120 of Figure 1), and setting an accessing time to access a second file on the server based on the time data from the first file (steps 130 and 140 of Figure 1, page 7, line 16 - page 8, line 2). The time data including the actual time when the second file is scheduled to be updated (e.g., corresponding to when files on a web site are scheduled to be “pushed” as indicated by a channel definition file, page 8, lines 2 - 4).

All of the independent claims recite time data that includes an actual time when a second file is scheduled to be updated.

Conventional network file search engines conduct searches for updated files on networks periodically, such as at regular intervals. One problem with these conventional systems is that these systems do not have any method for determining when a web site might be scheduled to be

updated. Depending on how often a web site is updated, the web crawler's archive data could be very outdated. On the other hand, frequent web crawler visits to web sites which are not frequently updated consume valuable computer resources.

The present invention provides a method for determining when and how often a web crawler should return to a web site. The present invention provides this advantage because the method downloads a first file on a network, accesses time data from within the first file and sets an access time to access a second file based upon the time data from within the first file, where that time data indicates when the second file is scheduled to be updated.

In an exemplary embodiment of the present invention, the method accesses a channel definition format (CDF) file which provides an indication of when a particular channel (and/or subchannel) is scheduled to be updated (see page 4, line 15 - page 5, line 2). Therefore, in this exemplary embodiment the first file is the CDF and the second file is the channel.

In this manner, the present invention provides for more efficient web crawling of a web site by crawling the site when and where it is likely the information contained therein is updated (page 6, lines 7-15).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants present the following issues for review by the Board of Patent Appeals and Interferences.

A. The Obviousness Rejection

Whether the references applied by the Examiner in the obviousness rejection teach or suggest all the claim limitations.

In particular, all of the independent claims 1, 7, 17, and 23 recite time data that includes an actual time when a second file is scheduled to be updated.

None of the applied references teaches or suggests time data that includes an actual time when a second file is scheduled to be updated.

B. The New Matter Rejection

Whether one of ordinary skilled in the art would recognize in the original disclosure a description of the invention defined by the amended claims.

In particular, all of the independent claims 1, 7, 17, and 23 were amended on June 7, 2005, to further clarify the distinctions over the applied references by adding the term “actual” to clarify that the time is an “existing” or “real” time and not a time which is predicted.

A person of ordinary skill in the would have understood, at the time the patent application was filed, that the claims as amended are supported by the original disclosure.

VII. ARGUMENT

A. Claims 1-23 are Non-Obvious Over the Applied References

The applied references do not teach or suggest all the claim limitations.

“To establish a prima facie case of obviousness, three basic criteria must

be met. . . Finally, the prior art reference (or references when combined) must teach or suggest all the claims limitations.” (M.P.E.P. § 2143).

None of the applied references teaches or suggests the features of the present invention including: 1) setting an accessing time to access a second file on a server based on time data that includes an actual time when the second file is scheduled to be updated (independent claims 1 and 17); 2) setting an accessing time to re-access a server based on time data that includes an actual time when a second file is scheduled to be updated (independent claim 7); and 3) means for setting an accessing time to access a second file on a server based on time data that includes an actual time when the second file is scheduled to be updated (independent claim 23).

All of the independent claims recite an actual time when a second file is scheduled to be updated.

The Examiner admits that the Ronning et al. reference “does not explicitly indicate: . . . the time data is an actual time for future updates (scheduled updates).” (Page 5, line 21 - page 6, line 2 of the December 8, 2004, Office Action).

The Examiner alleges that the Yamane et al. reference remedies the deficiencies of the Ronning et al. reference. However, the Examiner fails to present a *prima facie* case for obviousness by failing to provide a prior art reference that teaches or suggests all of the claim limitations.

In particular, the Examiner has failed to apply a reference that teaches or suggests an actual time when a second file is scheduled to be updated.

Indeed, the Examiner fails to allege that any of the applied references teaches or suggests

an actual time when the second file is scheduled to be updated.

Rather, the Examiner merely alleges that the Yamane et al. reference teaches “wherein the time data is an actual time for a future update (Figure 2, i.e. next update prediction time)” and “a system where it predicts a future update including setting an actual time ate (sic) of when this update will occur (Col 5, lines 48-56).” (Page 6, lines 5-6 and 11-12, respectively).

Contrary to the Examiner’s allegation, the Yamane et al. reference does not teach or suggest time data that includes an actual time when the second file is scheduled to be updated.

The Yamane et al. reference discloses a system that downloads data from a network by predicting when the data might be updated. The system disclosed by the Yamane et al. reference either looks for that information within the file (i.e., the last time the file was updated) or predicts when the data might be updated based upon the history of previous updates of the file. The system predicts when the data might be updated, downloads the data, checks to see if the data has really been updated and, if not, it refines the prediction of when the data might be updated (col. 8, lines 22 - col. 9, line 15).

In stark contrast, the present invention relies upon the actual time that the file is scheduled to be updated as specified by the server rather than relying upon some algorithm that is performed by a client that attempts to predict when the file might be updated. As noted by the Yamane et al. reference which acknowledges that the system must check to see has really been updated, the Yamane et al. reference merely attempts to predict when the file might be updated rather than relying upon the actual time that the file has been scheduled to be updated.

The Yamane et al. reference very clearly explains that a “next update prediction time

storage section 105 has the function of relating a link to the next update prediction time of the data item specified by the link, storing them, and outputting and updating the next update prediction time.” (Emphasis added, col. 4, lines 35-39).

Further, the Yamane et al. reference very clearly explains that an “update history storage section 108 relates a link to the update history (history table) of the data item specified by the link and stores them. The update history storage section 108 has the function of adding the update history and the function of calculating the next update prediction time of each link from the update history corresponding to each link.” (Emphasis added, col. 4, lines 42-48).

“Since all of the pieces of information stored in these storage sections are related through links, the next update prediction time storage section 105 and the update history storage section 108 may not have physically different storage units. Therefore, they are stored in a common storage unit to have the relationship as shown in FIG. 2.” (Emphasis added, col. 4, lines 57 - 62).

“First, the next update prediction time to be outputted and updated by the next update prediction time storage section 105 is stored so as to correspond to each link. As shown in FIG. 2, four next update prediction times July 1 12:00, July 1 17:00, July 1 20:00, (sic) are stored so as to correspond to the four links.”

In other words, the Yamane et al. reference discloses a system that downloads data from a network based upon a prediction of when the data might be updated. The system disclosed by the Yamane et al. reference either looks for that information within the file (i.e., the last time the file was updated) or predicts when the file might be updated based upon the history of previous updates of the file. The system predicts when the file might be updated, downloads the data,

checks to see if the data has really been updated and, if not, it refines the prediction of when the file might be updated (col. 8, lines 22 - col. 9, line 15).

In particular, the Yamane et al. reference very clearly explains that the update prediction times that are stored in the update prediction time storage section 105 are calculated “from the update history corresponding to each link.” (Col. 4, lines 44 - 47).

This very clearly illustrates that the Yamane et al. reference does not teach or suggest an actual time of when a file is scheduled to be updated, because the Yamane et al. reference is forced to perform a calculation based upon the history of previous updates of a corresponding file in order to predict (i.e., guess, estimate, assume) when the file might be updated.

In stark contrast to the Yamane et al. reference, the present invention relies upon the actual time that the file is scheduled to be updated as specified by the server rather than relying upon some algorithm that is performed by a client that attempts to predict when the file might be updated. As noted by the Yamane et al. reference which acknowledges that the system must check to see has really been updated, the Yamane et al. reference merely attempts to predict when the file might be updated rather than relying upon the actual time that the file has been scheduled to be updated.

Clearly, the Examiner’s citation of Figure 2, does not support the Examiner’s allegation that the Yamane et al. reference teaches or suggests time data that includes an actual time when the second file is scheduled to be updated.

Rather, Figure 2 of the Yamane et al. reference merely discloses a prediction of when a file might be updated.

Regarding the “Response to Arguments” in the August 19, 2005, Final Office Action, the Examiner alleges that Figure 2 discloses an “actual time” where “the next update is clearly indicated, for example, the file or the web page identified by the URL <http://www.a.co.jp> is scheduled to be updated at exactly 12:00 o’clock (sic) on July 1st.” (Emphasis original.)

However, the Examiner’s allegation that this update prediction time of, for example, 12:00 directly contradicts the disclosure of the Yamane et al. reference.

Firstly, the 12:00 update prediction time to which the Examiner refers is not a time when a file is scheduled to be updated. Rather, the Yamane et al. reference makes it very clear that the 12:00 time is a update prediction time.

Secondly, this 12:00 update prediction time to which the Examiner refers is also not time data that was accessed from within the first file as recited by the claims. Rather, the Yamane et al. reference explains that the 12:00 update prediction time is calculated based upon time data from a history table that stores time data regarding when a file has been updated in the past (i.e. the history of past updates).

Therefore, the 12:00 update prediction time is neither a scheduled update time, nor time data that was accessed from the first file regarding when that first file is scheduled to be updated.

Appellant respectfully requests a reversal of the Examiner’s rejection and allowance of the present application.

B. The Amended Claims are Supported by the Original Description

Claims 1-23 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply

with the written description requirement. Appellant respectfully submits that the originally filed disclosure adequately supports the claimed subject matter.

In particular, the Examiner points out that claims 1, 17, 17, and 23 were amended on June 7, 2004, to include the term “actual” and that “the term ‘actual’ . . . is not in the specification of the current application.”

Appellant respectfully submits that claims 1-23 comply with the written description requirement of 35 U.S.C. § 112, first paragraph by virtue of the fact that the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.

The standard for determining compliance with the written description requirement is clearly set for by the Manual of Patent Examining Procedure:

“Standard for Determining Compliance with the Written Description Requirement”

“[T]he fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the time of the filing date sought, applicant was in possession of the invention as now claimed.”

(Emphasis original, M.P.E.P. § 2163.02).

This inquiry appears not to have been undertaken by the Examiner. Indeed, the Examiner never alleges that the specification does not convey with reasonable clarity to those skilled in the art that, as of the time of the filing date sought, applicant was in possession of the invention as now claimed.

Rather, the Examiner merely points out that the term “actual” does not appear in the originally filed specification.

Such an allegation is *prima facie* insufficient to establish a lack of compliance with the written description requirement of 35 U.S.C. § 112, first paragraph.

Indeed, the M.P.E.P. specifically explains that an originally filed disclosure may adequately support the claims implicitly and/or inherently.

For the present instance, where the originally filed specification does not expressly disclose a claimed limitation the M.P.E.P. explains that:

“To comply with the written description requirement of 35 U.S.C. § 112, para.1, . . . , each claim limitation must be expressly, implicitly, or inherently, supported in the originally filed disclosure. When an explicit limitation in a claim ‘is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.’” (M.P.E.P. § 2163).

While the present specification as originally filed did not expressly include the term “actual” Appellant respectfully submits that support for that term is implicitly and/or inherently found in the originally filed disclosure.

Webster’s Encyclopedic Unabridged Dictionary of the English Language explains that “actual” means “existing in act of fact; real.”

The present specification explains that, in an exemplary embodiment, the data from the

first file is analyzed to determine when a second file is scheduled to be updated and that the accessing time is assigned based on when the second file is scheduled to be updated. (See, for example, page 5, lines 6-9).

For example, an exemplary embodiment of the present invention may access a channel definition file which includes a “SCHEDULE tag [that] indicates when a channel should be updated” (Page 2, lines 10-11) and that by using the SCHEDULE values this exemplary system “will access a website when” the website is scheduled to be updated.

The written description provides an example of a SCHEDULE tag that includes an actual time. In particular, the written description describes an exemplary SCHEDULE tag that indicates that a channel is scheduled to be updated between the earliest time of 2 and the latest time of 6. These times of 2 and 6 are “actual” times in that these times already exist in fact in the schedule and thus, are actual times.

Therefore, despite the fact that the written description does not use the term “actual,” Appellant respectfully submits that a person of ordinary skill would have understood, at the time the patent application was filed, that the originally filed written description inherently and/or implicitly discloses an “actual” time (i.e. a time that exists in fact).

The June 7, 2004, Amendment added the term “actual” to the claims to further clarify the distinction between an actual (i.e., existing, real, genuine, veritable) time when a file is scheduled to be updated and a non-actual (i.e. non-existent) time when a file might be predicted to be updated.

In other words, the Amendment to the claims, was intended to further clarify the

distinction between an existing/actual time in a schedule in accordance with the claimed invention and a prediction of a time which is clearly an estimated/guessed/prediction of a time which is non-existent (i.e. non-actual).

None of the applied references discloses a schedule that includes a time that is actual or exists in fact regarding when a file is scheduled to be updated. Rather, and in stark contrast, the applied references merely disclose keeping track of when a file has historically been updated and based upon that historical data attempting to predict when a file might be updated.

That prediction must be made because the “actual” or existing time that is scheduled to update the file does not exist and thus, is not “actual” in the disclosure of the applied references.

In other words, there would be no need to make any prediction at all regarding when a file might be updated, if a scheduled time existed in fact (i.e. was an actual time). Rather, the Yamane et al. reference recognizes that there is no actual scheduled time and, therefore, is forced to predict/guess/estimate a time at which a file might be updated.

In particular, as explained above, the claimed invention is directed to accessing a first file to access an actual (i.e. existing time) from within that first file to determine when that first file is scheduled to be updated.

Appellant respectfully submits that the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, appellant was in possession of the invention as now claimed. Therefore, Appellant respectfully requests a reversal of the Examiner’s rejection and allowance of the present application.

VIII. CLAIMS APPENDIX

Claim 1. A method for searching files stored on a network, comprising:
downloading a first file on the network from a server to a client;
accessing time data from within the first file; and
setting an accessing time to access a second file on said server based on said time data
from the first file, wherein said time data includes an actual time when said second file is
scheduled to be updated.

Claim 2. The method of claim 1, wherein the second file is an updated version of the first
file.

Claim 3. The method of claim 1, further comprising selecting a second file to download
based on said time data downloaded from the first file.

Claim 4. The method of claim 1, wherein said time data comprises a channel definition
format file (CDF).

Claim 5. The method of claim 1, wherein said setting an accessing time comprises:
analyzing the time data from the first file to estimate when a second file is scheduled to
be updated; and
assigning the accessing time based on said estimate of when the second file is scheduled

to be updated.

Claim 6. The method of claim 3, wherein said setting an accessing time comprises:
analyzing the time data from the first file to estimate when a second file is scheduled to
be updated; and
assigning the accessing time based on said estimate of when the second file is scheduled
to be updated.

Claim 7. A method for searching files on a network, comprising:
accessing a server on the network from a client;
downloading a first file from said server to said client;
accessing time data from within said first file; and
setting an accessing time to re-access the server based on said time data from the first file,
wherein said time data includes an actual time when a second file is scheduled to be updated.

Claim 8. The method of claim 7, further comprising:
accessing the server based upon the accessing time; and
downloading a second file from the server.

Claim 9. The method of claim 8, wherein the second file is an updated version of the first
file.

Claim 10. The method of claim 7, further comprising selecting said second file to download based on said time data downloaded from the first file.

Claim 11. The method of claim 8, further comprising selecting said second file to download based on said time data downloaded from the first file.

Claim 12. The method of claim 7, wherein said data comprises a channel definition format file (CDF).

Claim 13. The method of claim 7, wherein said setting an accessing time comprises:
analyzing the time data from the first file to estimate when a second file is scheduled to be updated; and
assigning the accessing time based on said estimate of when the second file is scheduled to be updated.

Claim 14. The method of claim 13, wherein the accessing time is after the scheduled update of the second file.

Claim 15. The method of claim 8, wherein said setting an accessing time comprises:
analyzing the time data from the first file to estimate when a second file is scheduled to be updated; and

assigning the accessing time based on said estimate of when the second file is scheduled to be updated.

Claim 16. The method of claim 10, wherein setting an accessing time comprises:
analyzing the time data from the first file to estimate when a second file is scheduled to be updated; and
assigning the accessing time based on said estimate of when the second file is scheduled to be updated.

Claim 17. A system comprising a machine readable recording medium storing a program for searching through files stored on a network, said program including executable instructions for:
downloading a first file on the network from a server to a client; and
accessing time data from within the first file; and
setting an accessing time to access a second file on said server based on said time data from the first file, wherein said time data includes an actual time when said second file is scheduled to be updated.

Claim 18. The system of claim 17, wherein the second file is an updated version of the first file.

Claim 19. The system of claim 17, further comprising selecting said second file to access

based on said time data downloaded from the first file.

Claim 20. The system of claim 17, wherein said time data comprises a channel definition format file (CDF).

Claim 21. The system of claim 17, wherein setting an accessing time comprises:
analyzing the time data from the first file to estimate when a second file is scheduled to be updated; and
assigning the accessing time based on said estimate of when the second file is scheduled to be updated.

Claim 22. The system of claim 19, wherein setting an accessing time comprises:
analyzing the time data from the first file to estimate when said second file is scheduled to be updated; and
assigning the accessing time based on said estimate of when the second file is scheduled to be updated.

Claim 23. A system for searching files stored on a network, comprising:
means for downloading a first file on the network from a server to a client;
means for accessing time data from within the first file; and
means for setting an accessing time to access a second file on said server based on said

time data from the first file, wherein said time data includes an actual time when said second file is scheduled to be updated.

IX. EVIDENCE APPENDIX

No evidence is being submitted with this brief on appeal and no evidence has been entered in the record by the Examiner or by the Appellant in the present application.

X. RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a court or the Board in any related appeals and/or interferences.

XI. CONCLUSION

In view of the foregoing, Appellant respectfully requests reversal of the final rejection and allowance of all of claims 1-23.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

Date: 12/19/05

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